

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

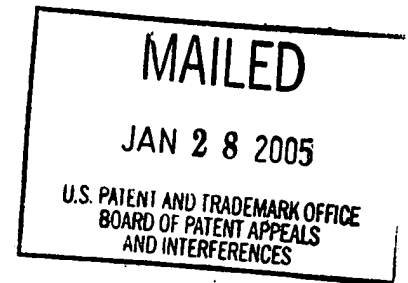
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT EASTMAN II

Appeal No. 2005-0104
Application 09/595,943

ON BRIEF



Before WARREN, KRATZ and PAWLIKOWSKI, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief,¹ and based on our review, find that we cannot sustain the grounds of rejections advanced on appeal:

claims 1, 3 through 5, 7, 10 through 15 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Vickers (answer, pages 3-5);

claims 9 and 18 through 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Vickers as applied to claims 1, 3 through 5, 7, 10 through 15 and 23, and further in view of Tsai et al. (Tsai) (answer, page 5);

claims 1 through 5, 7 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Anderson and Vickers (answer, pages 6-7);

¹ We have considered the brief filed March 18, 2004.

claims 1, 3 through 5, 7, 8 and 18 through 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsai in view of Anderson and Vickers (answer, pages 7-8); and

claims 1, 3 through 7, 9 through 16 and 18 through 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beavers in view of Anderson and Vickers (answer, pages 8-10).²

Rather than reiterate the respective positions advanced by the examiner and appellant, we refer to the answer and to the brief for a complete exposition thereof.

The dispositive issue in this appeal is whether one of ordinary skill in this art would have found the suggestion or motivation to modify the portable enclosures of Anderson, Smith, Tasi and Beavers by using a lining material comprising at least a binder having interspersed therein a multiplicity of carbon particles which can dampen, that is, absorb, to any extent the sent of a person, as required by the plain language of appealed independent claims 1, 10, 18, 19, 20 and 22,³ by teachings of Vickers to use an odor-absorbing layer or sheet comprising such material in articles of hunting clothing, without recourse to appellant's disclosure and claims (answer, e.g., pages 4, 5, 6, 7-8 and 9; brief, e.g., pages 11-13). *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) (citing *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)) ("Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure."); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988).

The examiner correctly finds that "Vickers teaches an odor-absorbing fabric/liner made of layers . . . used in hunting clothes to conceal the hunter, i.e., prevents his scent from reaching the animals" (answer, page 4), but fails to provide objective evidence in the applied references or

² Finally rejected and appealed claims 1 through 5 and 7 through 16 and 18 through 23, along with allowed claim 17 are all of the claims in the application. See the appendix to the brief.

³ We interpret the claim terms of appealed claims 1, 10, 18, 19, 20 and 22 by giving the terms their broadest reasonable interpretation in light of the written description in appellant's specification, including the drawings, as it would be interpreted by one of ordinary skill in this art, without reading into this claim any limitation or particular embodiment disclosed in the specification. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Priest*, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978).

other knowledge shown to be known in the art, establishing why one of ordinary skill in this art would have been motivated to extend the teaching of having the odor-absorbing layer immediately next to the body of the hunter in Vickers to an environment in which the odor-absorbing liner is part of a portable enclosure and is situated outside of the hunter's clothing. Indeed, the liner as part of an enclosure shown by Anderson, Smith, Tasi and Beavers would have limited proximity to even the *outer* surface of the hunter's clothing, with air between that surface and the surface of the liner, and there is no teaching in Vickers that the odor-absorbing layer thereof would function to dampening the scent of the hunter when positioned outside of the hunter's clothing as claimed. Thus, there is no scientific reason or objective evidence of record to support the proposition that "[t]his type of material [of Vickers] being transferable to other types of outdoor items, such as hunting blinds, tents, etc." (answer, page 11).⁴

In the absence of direction to the claimed invention within the disclosure of Vickers or in other knowledge established to be known in the art combined with the primary references, we agree with appellant's arguments that on this record, the only direction to appellant's claimed invention encompassed by the appealed claims resides in appellant's disclosure and claims.

Thus, on this record, the examiner has not established a *prima facie* case of obviousness and accordingly, we reverse the grounds of rejection.

⁴ The examiner refers to "the reference of Sesselmann" at page 11 of the answer which is not otherwise identified or included in the statement of any of the grounds of rejection. Thus, the reference made of record by appellant in the information disclosure statement of September 5, 2001, is not before us. Reliance on a reference to support a ground of rejection that is not included in the statement of the rejection is clearly impermissible. See *In re Hoch*, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n.3 (CCPA 1970); cf. *Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993).

The examiner's decision is reversed.

Reversed


CHARLES E. WARREN

CHARLES F. WARREN
Administrative Patent Judge

Peter F. Kutz

PETER F. KRATZ
Administrative Patent Judge

Beverly A. Pawlenty

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

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